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SMITH, GAMBRELL & RUSSELL, LLP  
 SUITE 3100, PROMENADE II  
 1230 PEACHTREE STREET, N.E.  
 ATLANTA, GA 30309-3592

EXAMINER

CHIN, RANDALL E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1744

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/072,148 | <b>Applicant(s)</b><br>SHELTON, JEFFERSON L. |  |
|                              | <b>Examiner</b><br>Randall Chin      | <b>Art Unit</b><br>1744                      |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.                      C
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 2-9 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 511/02
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 16-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the Paper filed November 24, 2003.
2. Applicant's election with traverse of Group I, claims 1-15, in the Paper filed November 24, 2003 is acknowledged. The traversal is on the ground(s) that the Examiner's identification of inventions I and II as being related as combination and subcombination has been incorrectly applied and that the inventions of Groups I and II are not distinct and the restriction requirement should not be made. This is not found persuasive because independent claim 16 (Jepson format) is deemed to positively recite the specific features of the kiln and kiln itself (i.e., plurality of ports, kiln). Notwithstanding, patentable weight is given to the kiln and plurality of ports.

The requirement is still deemed proper and is therefore made FINAL.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Numeral **106** in Fig. 3.

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Also, The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Attachment means **97** and receiving point **98** on p. 9, lines 18-19.

The drawings are objected to because the lead lines for numeral 31 in Figs. 1, 2, 3 and 4 should be reviewed and clarified since the lead line for numeral 31 in Fig. 1 appears to be incorrect. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

4. The disclosure is objected to because of the following informalities:

On p. 6, line 5, it appears "FIG. 6" should read --FIG. 5--.

On p. 6, line 14, "Boring bit 33" should read --Boring bit 43--.

On p. 6, lines 18 and 19, it appears the two occurrences of "adapter housing 80" should each instead read --adapter housing 90--. See p. 9, lines 12-19 which uses the numeral 80 to already designate linear actuator 80. Clarification is respectfully requested here.

On p. 8, line 9, it appears "second end 24" should read --second end 22--.

On p. 8, line 18, it appears "FIG. 6" should instead read -FIG. 5--.

Appropriate correction is required.

5. Claims 2, 3 and 12 recite the phrase "fluid communication means", however, claim 1 does not use such phrase. Consistent terminology should be used.

Clarification is respectfully requested with respect to the term "distal" in the recitation "distal said sleeve member" in claim 1, lines 6-7. Is the term "distal" here simply referring to the fact that the fluid jet 50 is just exterior or positioned outside of the sleeve member 60 as shown in Fig. 1 since technically, one could say that the fluid jet is also "proximally" positioned to this sleeve member 60 as shown in Fig. 1?

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Murphy '474.

The patent to Murphy '474 discloses a cleaning apparatus for penetrating and removing deposits from an internal wall of a tube or pipe comprising a rotary drive unit defined by hydraulic motor 84 operatively connected to a first end of a "drill" shaft 32, a honing tool or drill bit 34 (Fig. 13) suitable for drilling said deposits, attached to a second

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end of said drill shaft and oriented for coaxial rotation therewith (col. 4, lines 21-23), a portion of said drill shaft, intermediate said rotary drive unit and said drill bit, slidably received in a shroud or sleeve member (see optional shroud or sleeve arrangement around shaft 32 at col. 4, lines 23-25) permitting rotational and linear displacement of said drill shaft therein, and a fluid jet 62 (Fig. 13) projecting from an outer surface of said drill shaft distal said sleeve member, said fluid jet in communication with a pressurized fluid source through said drill shaft (col. 5, lines 16-35).

As for cleaning and penetrating and removing deposits from an internal wall of a kiln, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As for claim 10, the drill shaft is selectively extensible between a retracted position, wherein said drill bit is displaced proximal said sleeve, and an extended position, wherein said drill bit displaced distal said sleeve (compare Figs. 8 and 9 and see col. 6, lines 7-17).

As for claims 11 and 13, Murphy shows "linear" actuator means which may be carriage 82 or even chains 86 for selectively positioning said drill shaft between said retracted and extended positions (see col. 5, line 62 to col. 6, line 6).

As well as claim 12 is understood, the fluid jet can be continuously maintained between the extended and retracted positions.

As for claim 14, the actuator means further comprise guide means, said guide means comprising a guide rod 74 slidably received in at least one guide loop (see connector tees for guides 74 in Fig. 8 but not labeled explicitly) extending from and attached to an outer surface of said sleeve member through supports 80 (Fig. 8).

#### ***Allowable Subject Matter***

8. Claims 2-9 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Forsyth, Hess, Strunk, and Nolan teach various drilling or cleaning devices.

10. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

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If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.



R. Chin



Randall Chin  
Primary Examiner  
Art Unit 1744